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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,647	05/25/2006	Motoki Kato	289157US8PCT	5725
22850	7590	05/19/2010	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			KHAN, ASHER R	
			ART UNIT	PAPER NUMBER
			2621	
			NOTIFICATION DATE	DELIVERY MODE
			05/19/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/580,647	Applicant(s) KATO ET AL.	
	Examiner ASHER KHAN	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 1/26/2010 have been fully considered but they are not persuasive.

In re page 7-9, Applicants argue that Kato and Yamaguchi do not teach "selection means for selecting accompanying data to be played back ... which can be selected from data files different from a main AV stream".

In response the Examiner respectfully disagrees. Kato discloses selection means (play list) for selecting accompanying data to be played back ... which can be selected from data files (play list files; Fig. 2; 0157) different from a main AV stream (Clip, Figs. 2 and 3) which can be selected from data files different from a main AV stream (Play list files are different from Clip i.e. main AV files; Figs. 2, 13 and 14; 0157; 0170; 0227; 0225)

Claim Objections

1. Claims 1, 8 and 9 are being objected to because it has been held that the recitation that an element "can be" used to perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2002/0164152 to Kato et al. "Kato" in view of U.S. Patent 6,088,507 to Yamauchi et al. "Yamauchi"

As to claims 1, 8 and 9, Kato discloses a playback apparatus comprising: obtaining means for obtaining playback management information (Fig. 7, Play list; 0157) including first information having a main playback path (Figs. 7 and 39, Playitem (Main Path)) indicating a position of an AV stream file recorded on a recording medium and second information having a sub playback path (Sub Play Item (Sub-Path); 0262) indicating positions of sub files including accompanying data (Sub play item or audio) to be played back simultaneously with playback of main image data included in the AV stream file (Fig. 39; 0289-0293); selection means for selecting accompanying data to be played back, based on an instruction from a user (selection of a playlist, 0157), from among accompanying data to be played back simultaneously with the main image data included in the AV stream file referred to by the main playback path and the accompanying data included in the sub files, which can be selected from data files different from a main AV stream (Figs. 13 and 14; 0157; 0196-0197), referred to by the sub playback path (Fig. 39; 0157; 0289-0293); reading means for reading, if the accompanying data selected by the selection means is included in a sub file referred to by a sub playback path, the sub file referred to by the sub playback path together with the AV stream file referred to by the main playback

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path (0157; 0289-0293); and

playback means for playing back the main image data included in the AV stream file read by the reading means and the accompanying data included in the sub file selected by the selection means and read by the reading means (0157;0289-0293).

Kato does not expressly disclose a plurality of sub playback paths.

Yamauchi discloses a plurality of sub playback paths (Fig. 4A; Elementary streams 2-6).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Kato with the teachings of Yamauchi. Motivation to combine would have been to allow a user to have multiple sub playback paths so that a user is able to play audio in different languages for a movie or provide caption data in different languages so that a user friendly system could be obtained.

As to claim 2, Kato and Yamauchi as modified disclose everything claimed as applied in claim 1 above. Yamauchi further discloses wherein the first information includes a table defining the accompanying data included in the AV stream file referred to by the main playback path (movie A) and the accompanying data referred to by the sub playback paths (Selection of voice or subtitles), and the selection means selects the accompanying data to be played back, based on the instruction from the user, from among the accompanying data defined in the table (Fig. 9).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Kato with the teachings of Yamauchi. Motivation to combine would have been to allow a user to choose different video and different languages thus giving

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the user more control over the material the user wishes to watch through the use of a playlist.

As to claim 3 and 4, Kato and Yamauchi as modified disclose everything claimed as applied in claim 1 above. Yamauchi further discloses further comprising determining means for determining whether the playback apparatus has a function of playing back the accompanying data selected by the selection means, wherein if it is determined by the determining means that the playback apparatus has a function of playing back the accompanying data and if the accompanying data is included in a sub file referred to by a sub playback path, the reading means reads the sub file referred to by the sub playback path together with the AV stream file referred to by the main playback path, and the playback means plays back the main image data included in the AV stream file read by the reading means and the accompanying data included in the sub file selected by the selection means and read by the reading means (Col. 3, lines 35-64).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Kato with the teachings of Yamauchi. Rationale to combine would have been that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 5, Kato and Yamauchi as modified disclose everything claimed as applied in claim 1 above. Yamauchi further discloses wherein the table further defines

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accompanying attribute (channel number) information concerning accompanying data, and the determining means determines whether the playback apparatus has a function of playing back the accompanying data based on attribute information concerning the accompanying data defined in the table(Col. 3, lines 35-64).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Kato with the teachings of Yamauchi. Rationale to combine would have been that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 6, Kato and Yamauchi as modified disclose everything claimed as applied in claim 1 above. Kato further discloses wherein the second information includes type information concerning the types of the sub playback paths, file names of the sub files referred to by the sub playback paths, and IN points and OUT points of the sub files referred to by the sub playback paths (Fig. 39; 0289-0293).

As to claim 7, Kato and Yamauchi as modified disclose everything claimed as applied in claim 1 above. Kato further discloses wherein the second information further includes specifying information for specifying the AV stream file referred to by the main playback path to play back the sub playback paths simultaneously with the main playback path, and a time on the main playback path for allowing the IN points to be started in synchronization with the main playback path on the time axis of the main playback path (Fig. 39; 0289-0293).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks- Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621

/A. K./
Examiner, Art Unit 2621